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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/900,715	07/06/2001	Keith D. Allen	R-775	3970

7590  
DELTAGEN, INC.  
1003 Hamilton Avenue  
Menlo Park, CA 94025

10/03/2002

EXAMINER
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WOITACH, JOSEPH T

ART UNIT	PAPER NUMBER
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1632

DATE MAILED: 10/03/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/900,715

Applicant(s)

ALLEN, KEITH D.

Examiner

Joseph Voitach

Art Unit

1632

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☒ Claim(s) 1-25 are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Application/Control Number: 09/900,715

Page 2

Art Unit: 1632

### **DETAILED ACTION**

This application filed July 6, 2001, claims benefit to provisional applications 60/216,104, filed July 6, 2000, and 60/223,386, filed August 7, 2000.

Applicants' amendment containing the sequence listing filed December 31, 2001, paper number 4, has been received and entered. The specification has been amended. Claims 1-25 are pending and currently under examination.

### ***Election/Restriction***

Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-12, 17-23, drawn to a targeting construct comprising a polynucleotide sequence homologous to the sequence encoding protein phosphatase 2C and a selectable marker and the transgenic animal generated with said construct, and method of producing said construct, classified in class 536, subclass 23.1; class 800, subclass 8; class 800, subclass 21; class 800, subclass 3..
- II. Claims 13-15 and 24, drawn to method of identifying an agent which modulates activity of protein phosphatase 2C in a cell comprising a disruption in a phosphatase 2C gene, classified in class 435, subclass 325.

Art Unit: 1632

- III. Claims 16 and 25, drawn to an agent which modulates the expression of protein phosphatase 2C, unclassifiable because the nature of the agent is not specifically set forth.

The inventions are distinct, each from the other because of the following reasons:

Inventions I -III are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are drawn to different and separate products and methods which are materially different and capable of separate use. Specifically, the polynucleotide sequences and the animals can be used for *in vivo* assays to measure a physiological effect on an entire tissue or animal and the cells can be obtained separate from generating an animal and can be used for *in vitro* assays to study specific molecular signaling. The agent encompassed by group III is not clearly defined and could be identified by other methods and could be used in other assays. Each of Groups I-III are drawn to materially different inventions and would require a separate search and consideration.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, and recognized divergent subject matter, restriction for examination purposes as indicated is proper.

Art Unit: 1632

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Joseph Woitach whose telephone number is (703)305-3732.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Reynolds, can be reached at (703)305-4051.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist Pauline Farrier whose telephone number is (703)305-3550.

Papers related to this application may be submitted by facsimile transmission. Papers should be faxed via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center numbers are (703)308-4242 and (703)305-3014.

Joseph T. Woitach



DEBORAH CROUCH  
PRIMARY EXAMINER  
GROUP 1800-1630